

## **REMARKS / DISCUSSION OF ISSUES**

Claims 1, 3-12 are pending in the application. Claim 1 is the independent claim.

### **New Claim**

Claim 12 is new. Support for the subject matter of claim 12 is provided in the filed application, for example, at page 7, line 25.

### **Objection to the Claims**

The amendment to claim 1 remedies the objection set forth at page 2 of the Office Action.

### **Rejections under 35 U.S.C. § 102**

Claims 1, 5-7 and 9-11 are rejected under 35 U.S.C. § 102(e) in view of *Tiesler-Wittig* (US Patent Application Publication 2003/0031026). For at least the reasons set forth below, Applicants respectfully submit that this rejection is improper and should be withdrawn.

At the outset Applicants rely at least on the following standards with regard to proper rejections under 35 U.S.C. § 102. Notably, a proper rejection of a claim under 35 U.S.C. § 102 requires that a single prior art reference disclose each element of the claim.<sup>1</sup> Anticipation requires that each and every element of the claimed invention be disclosed in a single prior art reference.<sup>2</sup> Alternatively, anticipation requires that each and every element of the claimed invention be embodied in a single prior art device or practice.<sup>3</sup> For anticipation, there must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention.<sup>4</sup>

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<sup>1</sup> See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303, 313 (Fed. Cir. 1983).

<sup>2</sup> See, e.g., *In re Paulsen*, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); *In re Spada*, 911 F.2d 705, 15 USPQ2d 1655 (Fed. Cir. 1990).

<sup>3</sup> See, e.g., *Minnesota Min. & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992).

<sup>4</sup> See, e.g., *Scripps Clinic & Res. Found. v. Genentech, Inc.*, 927 F.2d 1565, 18 USPQ2d 1001 (Fed. Cir. 1991).

i. Claim 1

Claim 1 recites:

1. *A metal halide lamp, comprising:*

*a cylindrically-shaped discharge vessel along a longitudinal axis, said discharge vessel having a ceramic wall which encloses a discharge space comprising Xe and an ionizable filling, and*

*an outer bulb surrounding the discharge vessel along the longitudinal axis, a portion of a surface of the outer bulb facing away from the discharge vessel being shaped as a negative lens, **the discharge vessel and the outer bulb defining a circumferential space therebetween**, wherein the portion with respect to the longitudinal axis encompasses a segment of the outer bulb with a segment angle  $\alpha$  in a range between  $20^\circ \leq \alpha \leq 110^\circ$ .*

Applicants direct attention to Figs. 3A and 4A, which show the space between the discharge vessel 23 and the outer bulb 21.

In rejecting claim 1, the Office Action directs Applicants to paragraphs [0035]-[0040] of *Tiesler-Wittig* for the alleged teachings of claim 1. Specifically, the Office Action equates the outer bulb 20 and the lenses 30 for the alleged disclosure of the outer bulb as featured in claim 1. However, as shown in the cross-sectional views of Figs. 1, 2 and 2a of *Tiesler-Wittig*, the lenses 30 abut the outer bulb 20. Therefore, Applicants respectfully submit that there is no circumferential space between the discharge vessel 16 and the outer bulb 20 of *Tiesler-Wittig* as specifically recited in claim 1. Accordingly, the applied art fails to disclose at least one feature of claim 1, and claim 1 is patentable over *Tiesler-Wittig*. Moreover, claims 3-12, which depend directly or indirectly from claim 1, are patentable for at least the same reason and in view of their additionally recited subject matter.

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General Comments on Rejections of Dependent Claims

Since each of the dependent claims depends from a base claim that is believed to be in condition for allowance, Applicant believes that it is unnecessary at this time to argue the allowability of each of the dependent claims individually. Applicant does not, however, necessarily concur with the interpretation of any dependent claim as set forth in the Office Action, nor do Applicant concurs that the basis for the rejection of any dependent claim is proper. Therefore, Applicant reserves the right to specifically address the patentability of the dependent claims in the future, if deemed necessary.

Conclusion

In view of the foregoing, applicant(s) respectfully request(s) that the Examiner withdraw the objection(s) and/or rejection(s) of record, allow all the pending claims, and find the application in condition for allowance.

If necessary, the Commissioner is hereby authorized in this, concurrent, and further replies to charge payment or credit any overpayment to Deposit Account Number 50-0238 for any additional fees, including, but not limited to, the fees under 37 C.F.R. §1.16 or under 37 C.F.R. §1.17.

If any points remain in issue that may best be resolved through a personal or telephonic interview, the Examiner is respectfully requested to contact the undersigned at the telephone number listed below.

Respectfully submitted on behalf of:  
Phillips Electronics North America Corp.

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